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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,045	11/30/2000	Bernd Bruchmann	51035	8697

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EXAMINER

SHORT, PATRICIA A

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 03/27/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

T.D-5

Office Action Summary

Application No.

09/726045

Applicant(s)

Bruchmann et al

Examiner

Short

Group Art Unit

1712

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE One MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-13 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-13 are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
 - ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, drawn to an isocyanate compound, classified in class 560, subclass 330.
- II. Claims 4 and 5, drawn to a process of preparing an isocyanate compound, classified in class 560, subclass 336.
- III. Claims 6-13, drawn to a process of functionalizing compounds or surfaces containing at least one group reactive toward isocyanate by reacting with an isocyanate compound, classified in class 8, subclass 115.51.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed could be made by reacting a monoisocyanate with a compound of formula 3 and then converting the reaction product to a monoisocyanate compound of the formula I.

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as a process of modifying compounds or surfaces that do not contain groups reactive toward isocyanate.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Additionally, applicant is required to make the following elections of species.

Claims 1-13 are generic to a plurality of disclosed patentably distinct species comprising species for R¹ and R² that are 2,4-tolylene, 2,6-tolylene, 4,4'-diphenylmethylene, 2,4'-diphenylmethylene, 3-alkyl-4,4'-diphenylmethylene, 1,3-phenylene, 1,4 phenylene, 1,5-naphthylene, tolidinylene, biphenylene, tetramethylene, hexamethylene, docdecylene, alkyl pentamethylene-2-carboxylate, isophoronylene, 2-methylpentamethylene, 2,2,4-trimethyl-1,6-hexamethylene, 2,4,4-trimethyl-1,6-hexamethylene, 1,3-cyclohexylene, 1,4-cyclohexylene, 3-methylene-1-methyl-1-cyclohexylene, 2-butyl-2-ethylpentamethylene, 4-methyl-1,3-cyclohexylene, 4,4'-methylenebis(cyclohexylene), 2,4'-methylenebis(cyclohexylene), xylylene and tetramethylxylylene. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for R¹ and a single disclosed species for R², even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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Claims 1-13 are generic to a plurality of disclosed patentably distinct species comprising species for X that are covalent bond, O, S and NR³. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Claims 1-13 are generic to a plurality of disclosed patentably distinct species comprising species for Y are hydroxyl, amino, amide, carbonyl, carboxyl, mercapto, sulfonyl, sulfinyl, sulfenyl, sulfate, nitro, nitrile, isonitrile, cyanate, silyl silanyl, phosphine, phosphate, phosphite, phosphonate, acrylate, methylacrylate, allyl and vinyl. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Finally, if Group III is elected, applicant is required to make the following elections of species.

This application contains claims directed to the following patentably distinct species of the claimed invention: species for the component having at least one group reactive toward isocyanate that are ethylene glycol, propylene glycol, butanediol, pentanediol, hexanediol,

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glycerol, trimethylolpropane, pentaerythritol, sorbitol, sugar, ethylenediamine, butylenediamine, hexylenediamine, melamine, polyether polyol, polyester polyol, polyarylate polyol, polyvinyl alcohol, polyalkylenimine, polyalkyleneamine, polyamidoamine, polyacrylic acid, polymer bearing acid anhydride, wood, glass, textile, ceramic, leather, paper, plastic, stone, concrete, metal and metal alloy.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 6 and 7 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

This application contains claims directed to the following patentably distinct species of the claimed invention: species for the group reactive toward isocyanate that are hydroxyl, amino, amido, carboxyl and mercapto.

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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 6-8, 12 and 13 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

P. Short

March 21, 2002

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